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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,534	07/21/2003	Yoshihiro Fujita	019519-399	2815
7590 05/27/2004				
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EXAMINER				
LE, HOA VAN				
ART UNIT		PAPER NUMBER		
1752				

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/622,534

Applicant(s)

FUJITA ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 is/are allowed.
- 6) ☒ Claim(s) 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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This application is before the examiner for consideration on the merits.

- A. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-12, drawn to a composition, classified in at least class 430, subclass 493.
  - II. Claim 13-18, drawn to a process, classified in at least class 430, subclass 434.

Inventions of Group I and Group II are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for forming an image as claimed can be practiced with another known or commercially color developing replenisher in the art. Applicants should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction

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would not be removed.

B. However any process claim is permitted to be rejoined with a material claim provided (a) that the material claim is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in *re Ochoa*, 37 USPQ2d 1127 or *In re Brower*, 37 USPQ2d 1663 and MPEP 821.04.

C. Mr. Roger Lee elects the invention of Group I, composition claims 1-12 on 24 May 2004.

D. I. (1) It is allowed to claim by a functional, characteristic, physical and/or chemical property of a material and /or process. (2) However, a claimed functional, characteristic, physical and/or chemical property of a material and/or process carries with a risk (*In re In re Schreiber*, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, physical and/or chemical properties as claimed in accordance with the authority stated in *In re Best*, 195 USPQ 430; *Ex parte Maizel*, 27 USPQ2d 1662 or *Ex parte Phillip*, 28 USPQ2d 1302. The language "specific gravity...", "pH of ...or more" or the like is considered as the functional or characteristic property of a material.

II. *In re Schreiber*, 44 USPQ2d 1429 states that "A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in *Swinehart*... where the Patent Office has reasons that the

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functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on."

E. Applicant's prior art submission filed on 29 March 2002 has been considered to the extent of the English language as provided only.

F. The record shows that the assignee and its counsel fail to bring to the Office attention of the related Japanese patents and their pertinent teachings. Please the abstract of JP 11288067 and JP 11288067 and Abe (5,837,435).

G. The elected species of the desired product compound in Example 2 has been considered and searched. The consideration and searched are extended to the applied species. Other non-elected species have not been considered, searched or examined until all of the applied species being read within the general formula are overcome.

H. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe (5,837,435).

Abe discloses, teaches, and suggests a ready-to-use color developing/replenishing composition. The developing composition comprises up to 0.2 mol/l of a p-phenylenediamine color developing agent and about 1.1 to 3 times of the amount of color developing agent in the color developing replenisher, having a pH of up to 12 and a little higher pH value for a color developing replenisher, the specific gravity of up to 1.13, a sufficient amount of an alkylbenzenesulfonic acid or its salt and containing no alkanolamine. Please see the whole description of the applied reference, especially at col.3:36-40, 61-64, 4:20-24, 12:55 to 13-21. Example 1, Table 2, Color Developer Nos. 10 and 12 and their related ready-to-use replenisher in Example 2 at lines 23-33. At the level of one skilled in the art, it has reasons to be believed that the above cited teachings and suggestions of the desired replenishing compositions would have the same or about the same claimed characteristic or functional properties as those in the above claims. Since the above claims contain the characteristic or functional properties of the materials, it is required by law that applicants must show a convincing evidence that the claims do not have the same or about the same characteristic or functional properties as applied in Abe. In the absence of convincing evidence to the contrary as required by law, the claims are found to be rendered inherently characteristic or functional property as applied in Abe. Applicants are urged, requested and required to come forth with an evidence to speed up the prosecution and to avoid any later work since (1) an argument alone may have and be given a little to no value and (2) a claim would have no value if someone later shows the claimed characteristic or functional property from one or combined prior art.

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I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
24 May 2004

HOA VAN LE  
PRIMARY EXAMINER  
*Hoa Van Le*